

Application No.: 09/521,037
Amendment Dated September 29, 2004
Reply to Office Action dated: March 29, 2004

Attorney Docket No.: MOF-11

REMARKS

Claims 1-3, 5-10, 12-14, and 16-20 are pending and rejected in this application.

Claims 2, 3, 5, 8-20 are hereby cancelled without prejudice.

Claim 1 is amended as a combination of the previous subject matter of Claims 1 to 5. Applicant submits that no new matter has been added to such claims, nor have any new issues been raised therein. Support for such changes can be found, e.g., in previous claims 1 through 5.

Responsive to the rejection of claims 1-3, 5, 8-10, 12-14, and 16-20 under 35 U.S.C. § 103(a) as being unpatentable over Proceq SA (SM 55, SM 150) in view of JP 8-178770 (Kamibayashi) and further in view of Stein, Applicant has amended claim 1, and hereby otherwise traverses this rejection. Applicant submits that claims 1, 6, and 7 are now in condition for allowance.

Claim 1 as amended, recites in part:

a hydraulic jack...being configured for applying a preset pulling force on the stressed cable by means of a hook on the end of said jack....

15
Applicant submits that such an invention as set forth in each of claims 1, is neither taught, disclosed, nor suggested by any of the cited references, alone or in combination.

20
Based on the amendment to Claim 1, applicant respectfully submits that the arguments for patentability are now simpler, and that no reference, except the examiner's hypothetical combination have all the elements of the present invention.

Application No.: 09/521,037
Amendment Dated September 29, 2004
Reply to Office Action dated: March 29, 2004

Attorney Docket No.: MOF-11

Each of Kamibayashi (Fig. 3), Lipton '379 (Fig. 2), and McKernan '334 (Fig. 1) each disclose a tensiometer that employs a compression type load cell to facilitate the measurement of tension within a rope or cable. Meanwhile, Proceq SA does employ the use of a pulling force in order to measure the tensile force within highly stressed steel wires or strands. The primary reference Kamibayashi '770 discloses a rope-tension measuring device that uses a compression type load cell 4 and a micrometer 5 to determine a deflection amount H. Meanwhile, Proceq SA does indicate the use of a pulling force as part of a wire tension meter system using an expensive tensiometer..

5 However, the question is actually whether or not it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Kamibayashi '770 to replace the compression type load cell used therein with a pulling or tensile force load cell as employed by Proceq SA or vice versa. As set forth in MPEP § 2143.01, it has been held that if a proposed modification or combination of prior art would change the principle of operation of the prior art invention being modified, then 10 the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Rati*, 270 F. 2d 810,123 USPQ 349 (CCPA 1959). In that case, the court reversed the rejection thereby holding that the “suggested combination of references would require a substantial reconstruction and redesign of the elements shown in the 15 [primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate.” 270 F. 2d 813,123 USPQ 352.

An important distinguishing feature of the present invention is it requires no extensive excavation of surrounding concrete for a cable to be tested in a post-tension structure, a configuration having an advantage of the Kamibashi reference.

Like the situation occurring in *In re Rati*, Applicant submits that the modification of Kamibayashi '770 to use a pulling or tensile type load cell instead of a compression type load cell would in fact require a substantial reconstruction and redesign of the elements shown in Kamibayashi '770 as well as change the basic principle under which Kamibayashi was designed to operate.

More importantly, the present invention is much simpler and safer than the Proceq device, in unobvious ways. With the Proceq system, the device is affixed, and a desired amount of deflection is manually applied to the cable being tested. Force is then measured through an expensive tensiometer. In the present invention, the force is pre-set, therefore the tensiometer can be and is eliminated. Such change is not taught or suggested in the prior art as combined. In the present invention, it is only necessary to measure deflection, therefore incorporating a simple and elegant one step operation, not possibly envisioned with Proceq, but now envisioned with only impermissible hindsight.

Additionally, the present invention is inherently safer than the Proceq device. Applicant submits that in those instances where the cable is being tested is, for some reason, under excessive tension, the device of the present invention will still only apply its pre-set force and it does so without an operator manually cranking it. Opposititely,

Application No.: 09/521,037
Amendment Dated September 29, 2004
Reply to Office Action dated: March 29, 2004

Attorney Docket No.: MOF-11

the Proceq device must be hand cranked to a desired deflection. If the cable is defective under too much tension, reaching the maximum deflection could cause breakage, with the unfortunate operator in close proximity.

5 This is a very important and salient point, not brought forth before, in that the present invention, and prior art, are most likely used in difficult or "problem" situations, where breakage is a real possibility and danger.

10 Applicant respectfully requests that the rejections under 35 U.S.C. 103(a), pertaining to the newly amended claims be withdrawn, and a notice of allowance be forwarded to the undersigned. If the Examiner has any questions or comments that would speed prosecution of this case, the Examiner is invited to call the undersigned at

260/484-4526.

Respectfully submitted,



Randall J. Knuth
Registration No. 34,644

RJK

Petition for Extension of Time

Encs: Amendments to the Claims

(5 Sheets; pp. 8-12)

Explanatory Cover Sheet Page 1

Return Postcard

Check 8141 (\$475)

Customer No. 022855

RANDALL J. KNUTH, P.C.

4921 Desoto Dr.

Fort Wayne, IN 46815-4631

Telephone: 260/484-4526

Facsimile: 260/484-0185

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on: September 29, 2004.

Randall J Knuth, Reg. No. 45,384
Name of Registered Representative



Signature

September 29, 2004

Date